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09/577,294	05/23/2000	Andreas Bleckmann	BEIERSDORF 614-WCG	3516

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EXAMINER

WELLS, LAUREN Q

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 07/22/2003

25

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Applicati n N .

09/577,294

Applicant(s)

BLECKMANN ET AL.

Examiner

Lauren Q Wells

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Claims 1-12 are pending. The Amendment filed 4/17/03, Paper No. 24, amended claims 1-12.

#### ***Double Patenting Rejection Maintained***

The rejection of claims 1-12 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6-12 of copending Application No. 09/328,792; over claims 1-5 of copending Application No. 09/693,161; over claims 1-6 and 8 of copending Application No. 09/428,421 is MAINTAINED for the reasons set forth in the Office Action mailed 10/17/02, Paper No. 20, and those found below.

Applicant's request to hold this rejection in abeyance is noted. Since the instant Application and the copending Applications mentioned above are still pending, this rejection is maintained.

#### ***112 Rejection Maintained***

The rejection of claims 1 and 6 under 35 U.S.C. 112 is MAINTAINED for the reasons set forth in the Office Action mailed 10/17/02, Paper No. 20, and those found below.

(i) Regarding the phrase "lipids and lipophilic constituents", Applicant argues, "These terms are well defined in the art and one ordinary skill would be apprised of the scope of the limitation (previously used in claims of at least two other US patents at the time of this response). This argument is not persuasive. First, the Examiner respectfully points out that allowance of claims has no relevancy in considering patentability of claims in another application. In re Young, 36 CCPA 886, 173 F.2d 239, 662 OG 947, 81 USPQ 139 (1949). Second, the Examiner contends that the distinction between these

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terms is not well defined in the art and Applicant has not provided a showing that they are. The Examiner respectfully points out that lipophilic constituents are lipids and that lipids are lipophilic constituents.

(ii) Regarding the term “derivative”, Applicant argues, “It is unclear why one of ordinary skill would not be apprised of the scope of such a phrase. The examiner is reminded that. . .”Breadth of a claim is not to be equated with indefiniteness”. This argument is not persuasive. First, the Examiner respectfully points out that the claim is being rejected because its metes and bounds are unascertainable and not because of its breadth. It is not clear what the term derivative means in the context of claim 6.

Regarding Applicant’s argument that the term “cellulose derivative” appears in the claims of other patents, the Examiner again respectfully points out that allowance of claims has no relevancy in considering patentability of claims in another application.

(iii) Regarding the phrase “condensation products of polyglycols and amines”, Applicant argues, “Each of the terms in the phrase have a definite meaning within the art and as such one of ordinary skill in the art would be able to contemplate the scope of compounds defined by the term”. This argument is not persuasive. While each term in the above phrase has a dictionary definition, the definitions are not definite when considering the phrase as a whole. It is still not clear what is encompassed by this phrase. Is Applicant claiming all intermediate products and side products of such a reaction? What are these products?

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-6, 7-8, 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fanger et al. (6,153,204) in view of Albacarys et al (6,338,855).

The instant invention is directed toward a water-in-oil emulsion with a water phase with a content of water and optionally water-soluble substances totaling at least 75% and an oil phase with a content of lipids, emulsifiers and lipophilic constituents totaling at most 25%, whose oil phase is chosen from the group of lipids or lipid mixtures, where the total polarity of the lipid phase is between 20 and 30 mN/m, comprising at least one interface active substance, selected from the group consisting of alkylmethicone copolyols, alkyltrimethicone copolyols, and mixtures thereof, comprising one or more cationic polymers, and having a viscosity at 25 C which is less than 5000 mPa/s.

Fanger et al. teach sunscreens having ultraspectral protection. Exemplified is a water-in-oil emulsion comprising 1.5% laurylmethicone copolyol, 0.5% cetylmethicone copolyol, 4% capric/caprylic triglycerides, 4% glycerol, and water, wherein the water phase comprises 76% of the composition. Caprylic/capric triglyceride and dicaprylyl ether are disclosed as interchangeable oil phase constituents. The reference lacks an exemplification, viscosity parameters, and cationic polymers. See Col. 2, lines 32-34; Col. 4, line 53-Col. 5, line 2; Col. 8, line 1-Col. 12, line 30.

Albacarys et al. teach cleansing articles for skin and/or hair. Disclosed are water in oil emulsions that can comprise conditioning agents, such as chitosan salts. The conditioning agent is disclosed as comprising preferably 1-25% of a composition. See Col. 26, line 19-Col. 42, line 15.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute dicaprylyl ether for caprylic/capric triglyceride in example 6 of the reference because Fanger et al. teach caprylic/capric triglyceride and dicaprylyl ether as interchangeable oil phase constituents in their emulsions.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the chitosan salts of Albacarys et al. to the emulsion of Fanger et al. because Fanger et al. teach that moisturizers, which are synonymous to conditioning agents, can be added to their compositions, and Albacarys et al. teach their conditioning components as improving the appearance and/or feel of mammalian skin upon/after topical application; thus, one of skill in the art would be motivated to add the chitosan salts of Albacarys et al. to the compositions of Fanger et al. because of the expectation of achieving improved appearance and/or feel of the skin.

It is noted that the viscosity parameters must be met if all the limitations of the composition are met.

Claims 2, 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fanger et al. in view of Albacarys et al. as applied to claims 1, 3-6, 7-8, 11-12 above, and further in view of Mahieu et al. (5,616,746) and Philippe et al. (2002/0064539).

Fanger et al. and Albacarys et al. are applied as discussed above. The references lack the water phase comprising greater than 80% of the emulsion.

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Mahieu et al. teach cosmetic compositions of the water-in-oil type, wherein the aqueous phase can comprise 30-85% of the composition. Specifically exemplified is a water-in-oil emulsion comprising cetyldimethicone copolyol and glycerine. See Col. 4, line 30-line 67; Col. 13, line 54-Col. 14, line 3.

Philippe et al. teach cosmetic or dermatological compositions in the form of skincare products, make-up products, or antisun products. Water in oil emulsions, wherein the aqueous phase comprises 50-98.9% of the emulsion, are disclosed. See [0091]-[0096]

It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the emulsion of the combined references as comprising greater than 80% of the aqueous phase because Philippe et al. teach that water-in-oil emulsions, wherein the aqueous phase comprises greater than 80% are known and useful in the cosmetic art, and Mahieu et al. specifically teach water-in-oil emulsions comprising cetyldimethicone copolyol and glycerine as having aqueous phases comprising 85% of the emulsions.

### ***Response to Arguments***

Applicant argues that the inherency of viscosity limitations is not shown. This argument is not persuasive. The Examiner respectfully points out that it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art (In re Aller, 105 USPQ 233) and that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d272, 205 USPQ 215 (CCPA 1980). Thus, since the combined references teach water in oil emulsions for cosmetic use, wherein the

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emulsions comprise the same constituents and since it is well known in the cosmetic art to modify viscosity to achieve a certain consistency and a good feel to skin, it would have been obvious to one of ordinary skill in the art to modify the viscosity to achieve good skin feel.

Applicant argues, "There is no teaching or suggestion that these general teaching are equally applicable to the water-in-oil emulsions taught by Fanger". This argument is not persuasive. The Examiner respectfully points out that Albacarys et al. specifically teach, in Col. 26, water-in-oil emulsions as preferred forms of their cosmetic compositions, wherein the addition of cationic polymers to such emulsions imparts conditioning the skin. Thus, one of skill would be motivated to chitosan salts taught by Albacarys et al. to the emulsions of Fanger because of the expectation of imparting conditioning to the skin.

Applicant argues, "If the examiner argues that she is only using a specific portion of the Albacary's reference to be combined with the Fanger reference, it has previously been held that 'it is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art'". This argument is not persuasive. First, the Examiner has not made this argument. Second, as described above, the Examiner is not "picking and choosing", as there is clear indication why one of skill would add a chitosan salt to a water-in-oil emulsion, based on the teachings of Albacarys et al.

Applicant argues, "the water content attributed by the examiner to Mahieu et al. and Phillipe et al. are for their own respective inventions and there is not factual basis for



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the assertion that these water limitations are equally applicable for the invention of Fanger et al". This argument is not persuasive. It is respectfully pointed out that Mahieu et al. and Phillipe et al. are relied upon to teach that it is well known in the art to modify the amount of water in a water-in-oil emulsion to form skin care products of optimum consistency and feel of the product when applied to the skin. As pointed out above, it is again respectfully pointed out that it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-4:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw  
July 18, 2003



THEODORE J. CRIARES  
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GROUP 1200/600